

Application Serial No. 10/001,992
Request for Continued Examination filed May 27, 2008
Reply to final Office Action mailed March 17, 2008

REMARKS

Claims 1, 3-10, 13-18 and 21-25 are pending in this application. Claims 1, 18, 21, and 22 are amended herein. Support for the amendments to the claims may be found in the claims as originally filed. Reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments, and the new grounds of rejection. Further favorable reconsideration is requested.

Claim Rejections - 35 U.S.C. § 112:

Claims 1, 3-10, 13-18 and 21-25 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1, 18, 21, and 22 were amended to make them more definite. Claim 1, for example, now recites "an advertisement utilization unit which, when a user is identified as a subscription user to the database upon entering user information, allows the subscription user to view the advertisement on said Web page open to the public," rather than "an advertisement utilization unit which, when a user is identified as a contract user registered in the database, allows the contract user to view said advertisement on the non-contract use page." Claims 1, 3-10, 13-18 and 21-25 are thus believed to be definite within the meaning of 35 U.S.C. § 112, second paragraph. Withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 1, 3-10, 13-16, 18 and 21-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over M. Aoki, Dai Nippon Printing Co. Ltd. Starts Internet Circular Service (hereinafter "Orikomio,") in view of the section of the subject application entitled "Background," and further in view of U.S. Patent No. 7,243,129 to Thomas (hereinafter "Thomas"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

The fourth clause of claim 1 recites:

When a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract.

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Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest “when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract,” as recited in claim 1. In Orikomio, rather, a user has only to enter the zip code of the area of which information is required to utilize the service for perusing information about retailers in the area and advertisements. In particular, as described at the beginning of the second paragraph on the first page of the translation of Orikomio:

When a user utilizes this service, he has only to enter the zip code of the area of which information is required, for perusing information about retailers in this area and advertisements.

Since, in Orikomio, a user has only to enter the zip code of the area of which information is required to utilize the service for perusing information about retailers in the area and advertisements, Orikomio does not describe “when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract,” as recited in claim 1.

With respect to the Background of the subject application, Orikomio is described as allowing the user to view advertisements, etc. of a desired area by allowing the user to input the postal code of the corresponding area. In particular, as described at page 2, lines 21-27, continuing at page 3, line 1:

Moreover, in recent years, with respect to an advertising system of a local area contacting type utilizing the Internet, the Internet inserted-bill supplying service, “Orikomio! ®”, which allows the user to view advertisements, etc. of a desired area by allowing the user to input the postal code of the corresponding area, has started in a limited area.

Since Orikomio allows the user to view advertisements, etc. of a desired area by allowing the user to input the postal code of the corresponding area, Orikomio does not describe “when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract

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registration processing by presenting an application page of said subscription contract," as recited in claim 1.

As described further in the Background of the subject application, Orikomio allows general users and registered users to view desired pages free of charge. In particular, as described at page 3, lines 3-11:

In this system, advertisements and recruitment information that have been registered by advertisers such as retail outlets with the payment of advertising fees are placed on the Web pages for three days so that general users and registered users are allowed to view desired pages for free of charge, and this system is expected as an advertising system of the local area contacting type.

Since Orikomio allows general users and registered users to view desired pages free of charge, Orikomio does not describe "when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract," as recited in claim 1.

The final Office Action acknowledges graciously at page 4, lines 7-11, that:

However Orikomio failed to teach when a viewing request from a user identified as a non-contract user not registered in said database is received, prohibits publication of said advertisement on said non-contract use page and publishes an application page for subscribing with said newspaper dealer.

The final Office Action seeks to compensate for this deficiency of Orikomio by combining Orikomio with Thomas, saying at page 4, lines 11-16, that:

Thomas teaches when a user is determined to be a new user a registering processing is invoked which operates to register the new user with the demographics identifying server. Once the user is registered the user is required to login (see fig. 5 and col. 6 lines 15-67).

Since, as noted in the final Office Action, Thomas registers a new user with a graphics identifying server, Thomas does not describe "when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract," as recited in claim 1. Thus, even if Orikomio, the Background, and Thomas were combined as proposed in the final Office Action, claim 1 would not result.

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In Thomas, moreover, the initial page request may be a login page in which the *user* is able to login to the demographics identifying server 308, rather than when “a viewing request is identified as that from a non-contract user not registered in said database,” as recited in claim 1. In particular, as described at column 6, lines 65, 66, and 67:

The initial page request may be a login page in which the user is able to login to the demographics identifying server 308.

Since, in Thomas, the initial page request may be a login page in which the user is able to login to the demographics identifying server 308, Thomas does not describe “when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract,” as recited in claim 1.

In Thomas, moreover, the *user* can login using a user name and password, rather than when “a viewing request is identified as that from a non-contract user not registered in said database,” as recited in claim 1. In particular, as described at column 6, line 67, continuing at column 7, lines 1-4:

As an example, the user can login using a user name and password which are entered by the user and transmitted to the user login processor 312 that determines whether the login request of the user is accepted or denied.

Since, in Thomas, the user can login using a user name and password, Thomas does not describe “when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract,” as recited in claim 1.

Finally, in Thomas, the demographics identifying server 308 is able to retrieve a demographics identifier for the *user* from the demographics identifier database 316 once the user has completed the login, rather than when “a viewing request is identified as that from a non-contract user not registered in said database,” as recited in claim 1. In particular, as described at column 7, lines 4-7:

Once the user has completed the login, the demographics identifying server 308 is able to retrieve a demographics identifier for the user from the demographics identifier database 316.

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Since, in Thomas, the demographics identifying server 308 is able to retrieve a demographics identifier for the user from the demographics identifier database 316 once the user has completed the login, Thomas does not describe “when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract,” as recited in claim 1. Thus, even if Orikomio, the Background, and Thomas were combined as proposed in the final Office Action, claim 1 would not result.

Finally, the final Office Action asserts at page 4, lines 13-16, that:

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to require Orikomio's subscriber to register for the online publication or newspaper for the intended purpose of providing customized or personalized web page as taught in Thomas.

Orikomio, to the contrary, is trying to address the *decreasing* tendency toward subscription by young people including those in their twenties. Orikomio, in fact, wants to *avoid* making young people register, in order to raise their chances to receive regional information. In particular, as described in the first full paragraph on the first page of Orikomio:

Recently, there is a decreasing tendency toward subscription by young people including those in their twenties, and they have only a few chances to receive regional information.

It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would not have been motivated to modify Orikomio as proposed in the final Office Action, because Orikomio wants to avoid making young people register.

Furthermore, since Orikomio, as discussed above, wants to *avoid* making young people register, modifying Orikomio as proposed in the final Office Action would render Orikomio unsatisfactory for its intended purpose. As provided in M.P.E.P. §2143.01:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Since modifying Orikomio as proposed in the final Office Action would render Orikomio unsatisfactory for its intended purpose, there is no suggestion or motivation to make the

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proposed modification, *In re Gordon*. Claim 1 is thus submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3-10 and 13-16 depend from claim 1 and add additional distinguishing elements. Claims 3-10 and 13-16 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3-10 and 13-16 is earnestly solicited.

Claims 18, 20, and 21:

The fifth clauses of claims 18, 20, and 21 recite:

When a viewing request is identified as that from a non-contract user not registered in said database, prohibiting publication of said advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permitting subscription contract registration processing by presenting an application page for subscribing with said newspaper dealer.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "when a viewing request is identified as that from a non-contract user not registered in said database, prohibiting publication of said advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permitting subscription contract registration processing by presenting an application page for subscribing with said newspaper dealer," as discussed above with respect to the rejection of claim 1.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claims 18, 20, and 21 are thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claims 18, 20, and 21 is earnestly solicited.

Claim 23:

The seventh clause of claim 23 recites:

Wherein the advertisement display is provided to the subscription user at an independent time and by a different medium from the first non-privileged service.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "wherein the advertisement display is provided to the subscription user at an independent time and by a different medium from the first non-privileged service," as discussed above with respect to the rejection of claim 1.

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Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claim 23 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 23 is earnestly solicited.

Claim 24:

The fifth clause of claim 24 recites:

When a user is identified as a non-contract user not registered in said database, publishing an application page for subscribing with said newspaper dealer.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "when a user is identified as a non-contract user not registered in said database, publishing an application page for subscribing with said newspaper dealer," as discussed above with respect to the rejection of claim 1.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claim 24 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 24 is earnestly solicited.

Claim 25:

The sixth clause of claim 25 recites:

Publishing, when a user is identified as a non-contract user not registered in said database, an application page for subscribing to said first non-privileged service.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "publishing, when a user is identified as a non-contract user not registered in said database, an application page for subscribing to said first non-privileged service," as discussed above with respect to the rejection of claim 1.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed

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above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claim 25 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 25 is earnestly solicited.

Claims 1, 3-10, 13-16, 18 and 21-25:

Claims 1, 3-10, 13-16, 18 and 21-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Orikomio, the Background, and Thomas, and further in view of U.S. Patent Application Publication No. 2002/0040374 to Kent (hereinafter "Kent"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract," as discussed above with respect to the rejection of claim 1. Kent does not either, and thus cannot make up for the deficiencies of either Orikomio, the Background, or Thomas with respect to claim 1.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claim 1 is thus submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 3-10 and 13-16 depend from claim 1 and add additional distinguishing elements. Claims 3-10 and 13-16 are thus also submitted to be allowable. Withdrawal of the rejection of claims 3-10 and 13-16 is earnestly solicited.

Claims 18, 20, and 21:

The fifth clauses of claims 18, 20, and 21 recite:

When a viewing request is identified as that from a non-contract user not registered in said database, prohibiting publication of said advertisement on said

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Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permitting subscription contract registration processing by presenting an application page for subscribing with said newspaper dealer.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "when a viewing request is identified as that from a non-contract user not registered in said database, prohibiting publication of said advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permitting subscription contract registration processing by presenting an application page for subscribing with said newspaper dealer," as discussed above with respect to the rejection of claim 1. Kent does not either, and thus cannot make up for the deficiencies of either Orikomio, the Background, or Thomas with respect to claims 18, 20, and 21.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claims 18, 20, and 21 are thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claims 18, 20, and 21 is earnestly solicited.

Claim 23:

The seventh clause of claim 23 recites:

Wherein the advertisement display is provided to the subscription user at an independent time and by a different medium from the first non-privileged service.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "wherein the advertisement display is provided to the subscription user at an independent time and by a different medium from the first non-privileged service," as discussed above with respect to the rejection of claim 1. Kent does not either, and thus cannot make up for the deficiencies of either Orikomio, the Background, or Thomas with respect to claim 23.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

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Claim 23 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 23 is earnestly solicited.

Claim 24:

The fifth clause of claim 24 recites:

When a user is identified as a non-contract user not registered in said database, publishing an application page for subscribing with said newspaper dealer.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "when a user is identified as a non-contract user not registered in said database, publishing an application page for subscribing with said newspaper dealer," as discussed above with respect to the rejection of claim 1. Kent does not either, and thus cannot make up for the deficiencies of either Orikomio, the Background, or Thomas with respect to claim 24.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claim 24 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 24 is earnestly solicited.

Claim 25:

The sixth clause of claim 25 recites:

Publishing, when a user is identified as a non-contract user not registered in said database, an application page for subscribing to said first non-privileged service.

Neither Orikomio, the Background, nor Thomas teach, disclose, or suggest "publishing, when a user is identified as a non-contract user not registered in said database, an application page for subscribing to said first non-privileged service," as discussed above with respect to the rejection of claim 1. Kent does not either, and thus cannot make up for the deficiencies of either Orikomio, the Background, or Thomas with respect to claim 25.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

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Claim 25 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 25 is earnestly solicited.

Claim 17:

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Orikomio and Kent, and further in view of U.S. Patent Application Publication No. 2002/0019768 to Fredrickson (hereinafter "Fredrickson"). The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

Claim 17 depends from claim 1 and adds further distinguishing elements. Neither Orikomio nor Kent teach, disclose, or suggest "when a viewing request is identified as that from a non-contract user not registered in said database, prohibits publishing of the advertisement on said Web page, and after publishing said non-contract user utilization page, allowing viewing said page, permits subscription contract registration processing by presenting an application page of said subscription contract," as discussed above with respect to the rejection of claim 1. Fredrickson does not either, and thus cannot make up for the deficiencies of either Orikomio or Kent with respect to claim 17.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claim 17 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 17 is earnestly solicited.

Claim 23:

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Orikomio and Kent. The rejection is traversed to the extent it would apply to the claims as amended. Reconsideration is earnestly solicited.

Neither Orikomio nor Kent teach, disclose, or suggest "wherein the advertisement display is provided to the subscription user at an independent time and by a different medium from the first non-privileged service," as discussed above with respect to the rejection of claim 1.

Nor would persons of ordinary skill in the art at the time the invention was made have been motivated to modify Orikomio as proposed in the final Office Action, as also discussed

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above with respect to the rejection of claim 1, because Orikomio wants to avoid making young people register.

Claim 23 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 23 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 3-10, 13-18 and 21-25 are allowable over the cited references. Allowance of all claims 1, 3-10, 13-18 and 21-25 and of this entire application is therefore respectfully requested.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: May 27, 2008

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